

## **REMARKS**

### **INDEPENDENT CLAIMS 25 and 33**

Pending independent claims 25 and 33 are rejected under 35 U.S.C. § 103(a) over the combination of Kraft, Yoo and Cook, along with applying what the Examiner calls “common sense” to render a key claim limitation obvious. The Applicant respectfully submits that these rejections are improper and must be withdrawn.

#### **The Examiner Has the Legal Burden to Prove All Elements**

To make a prima facie case under section 103, the Examiner’s burden includes (but is not limited to) citing references that teach or suggest all of the features of a claimed invention. *E.g., In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995). If the references fail to teach or suggest one or more elements, the Examiner’s prima facie case is flawed for failing to meet this legal standard.

Independent claims 25 and 33 recite a “safe volume profile providing a default volume setting...selected to reduce the risk of damage to a user’s hearing if the mobile device [“second speaker” in claim 33] is operated in close proximity to the user’s ear while in the handsfree mode of operation.” The Examiner acknowledges that this limitation, of limiting the initial volume to a lower level, is not disclosed nor suggested by the cited references.

Thus the Examiner’s prima facie case has a deficiency. This deficiency is fatal to the obviousness rejections.

The Examiner purports to make up for this deficiency by concluding “it would have been obvious that by common sense the volume set by the user could have been a safe volume setting so that user’s ears would be less likely being damaged.” (Office Action, p.3, 1<sup>st</sup> par.)

This basis for rejection is improper for at least two reasons. First, the Examiner’s reliance on “common sense” does not qualify as evidence for rendering the limitation obvious. Secondly, even if

the Examiner's "common sense" basis were proper evidence, it could not be combined with the other references to arrive at claims 25 and 33, because the primary reference to Kraft teaches away from it. The rejection is further deficient in that it represents agency action that is arbitrary, capricious and unreasonable.

**An Unsupported Assertion of "Common Sense" Is Not Evidence.**

An unsupported assertion of "common sense" is not evidence. *In re Lee*, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002) (agency assertion of expertise and "common sense" are not evidence, and cannot serve as a substitute for evidence). The recently decided case of *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 127 S. Ct. 1727, 82 USPQ2d 1385, 1397 (2007), does not in any way alter the principle that a bare assertion of "common sense" is not a substitute for evidence. In *KSR*, all claim elements were known in the prior art, having been disclosed by three references to Anano, Smith and Rixon. The Supreme Court did not hold—nor did it need to hold—that if an element is missing, the deficiency may be "cured" by an unsupported assertion of "common sense."

The Supreme Court raised the matter of "common sense," not in connection with supplying missing elements, but in connection with combining elements disclosed by various disparate references. And even then, the Court did NOT say that all one needs to do to support a finding of an obvious combination was to merely make an unsupported assertion of "common sense." Rather, the Court devoted approximately a dozen pages (of its slip opinion) to discussion of the various references, what they disclosed, how they added to knowledge of one skilled in the art, the technological trends, how the references indicated the predictable performance of various combinations of elements, and so forth.

The Supreme Court's opinion discussed an evidentiary record that specifically disclosed all elements of the contested claim. The Supreme Court's opinion also contained a detailed and reasoned analysis of the evidence in question.

The Examiner's rejection did neither.

The rationale of KSR does not support the Examiner's rejection, and neither do the MPEP guidelines dealing with KSR. The MPEP's guidelines apply where the limitation to be added is already "known in the prior art":

"[T]he Supreme Court reaffirmed principles based on its precedent that "[t]he **combination of familiar elements** according to known methods is likely to be obvious when it does no more than yield predictable results." ... [t]he Court recognized that when a patent claims a structure **already known in the prior art** that is altered by the mere substitution of one element for **another known in the field**, the combination must do more than yield a predictable result." Id. at \_\_\_, 82 USPQ2d at 1395. (2) "In Anderson's-Black Rock, Inc. v. Pavement Salvage Co., . . . [t]he two [**pre-existing elements**] in combination did no more than they would in separate, sequential operation." Id. at \_\_\_, 82 USPQ2d at 1395. (3) "[I]n Sakraida v. AG Pro, Inc., the Court derived . . . the conclusion that when a patent simply **arranges old elements** with each performing the **same function it had been known to perform** and yields no more than one would expect from such an arrangement, the combination is obvious." Id. at \_\_\_, 82 USPQ2d at 1395-96 (Internal quotations omitted.). The principles underlining these cases are instructive when the question is whether a patent application claiming the **combination of elements of prior art** would have been obvious. The Supreme Court further stated that: ... When considering obviousness of a **combination of known elements**, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." Id. at \_\_\_, 82 USPQ2d at 1396." (MPEP 2141 (I), emphasis added)

Even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicant is entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

### **The References Teach Away from the Claimed Combination**

Furthermore, even if this limitation were disclosed in the prior art, it could not be combined with the cited references to arrive at claims 25 and 33. That is because Kraft ([0022]) teaches away from this limitation by explaining that in “hands free” mode, for use when driving, the sound level is preset to the highest volume level – level 5 in Table 2 (Level “5” is identified in Table 1 as the highest volume level in the “sound volume” category). Kraft’s teaching of presetting the **highest** volume setting for handsfree mode thus teaches away from the claim step of initially limiting the volume to a **lower** level. And references cannot be combined where a reference – in this case the primary reference to Kraft – teaches away from the limitation, as the MPEP explains:

**“2. References Cannot Be Combined Where Reference Teaches Away from Their Combination.** It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)” MPEP 2145 (X)(2)

In conclusion, the rejection of claims 25 and 33 should be withdrawn, because its basis for finding the key limitation obvious does not comply with the MPEP guidelines on either official notice or KSR, and the primary reference teaches away from the limitation.

### **The USPTO is acting Arbitrarily, Capriciously and Unreasonably.**

Under the Administrative Procedure Act, an agency may not act in an arbitrary or capricious manner, or abuse its discretion, or otherwise act contrary to law. The procedural posture of this matter demonstrates that the United States Patent and Trademark Office is acting unreasonably, and is arbitrarily and capriciously denying the Applicant a patent upon plainly untenable grounds.

The Applicant does not make this argument lightly. In the Final Office Action issued on February 2, 2009, the Examiner rejected each of the pending claims under 35 U.S.C. § 103(a). It was pointed out, and was not disputed by the Examiner, that the Examiner’s prima facie case failed to include the element of a “safe volume profile providing a default volume setting...selected to

reduce the risk of damage to a user's hearing if [the mobile device or a speaker] is operated in close proximity to the user's ear while in the handsfree mode of operation." The Examiner, citing no evidence of any such element, concluded that element was inherent.

The Applicant filed a pre-appeal brief conference request, asserting the inherency assertion was without legal merit, and that the Examiner's prima facie case was fatally flawed for failure to show all elements.

In response, the USPTO issued a communication dated July 28, 2009, withdrawing the rejection and reopening prosecution.

Thereafter, the Examiner issued a new office action that:

cited NO new evidence,

failed to include ANY evidence pertaining to the element in question, and

sought to fill in the evidentiary gap with a bare assertion of "common sense."

Considering the prosecution history of this matter, the record indicates that the rejection of the Applicant's claims is not based upon evidence and reasoned argument. Instead the rejection is arbitrary and capricious and unreasonable.

#### **NEW INDEPENDENT CLAIM 41**

Without waiving any of the arguments mentioned above, the Applicant herewith submits a new set of claims that is patentable over the references in the record. In claim 41, similar to claims 25 and 33, when the mobile device is initially switched to handsfree mode, the mobile device initially limits the volume to a preset initial level. After the volume has been initiated at the preset initial level, the user can raise the volume to a level higher than the preset initial level.

This limitation, of initially limiting the volume in handsfree mode to a preset lower initial level, is not made obvious by the references as explained above. Accordingly, claim 41 is patentable over the references of record.

**NEW DEPENDENT CLAIMS 42-43**

Claim 42 adds, to claim 41, the limitation that the mobile device enables the user to raise the volume above the preset initial level “only after the volume has remained at the preset initial level for a finite time period” (“finite” meaning nonzero). This limitation was included, with different wording, in original claims 3 and 5. The “finite time period” is limited in claim 43 to “about a few seconds”, as supported in the published application at [0035]. The references do not suggest preventing the user from raising the volume for a “finite length of time” per claim 42, and especially not for “a few seconds” per claim 43. Accordingly, the limitations that claims 42 and 43 add to claim 41 distinguish them further from the prior art.

**REMAINING DEPENDENT CLAIMS 26, 29-32, 34, 37-40 AND 44-46**

The remaining dependent claims are further distinguished from the prior art by the limitations they add to the independent claims.

The application is therefore in condition for allowance.

Respectfully submitted,

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